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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,543	11/09/2001	Rudolf Pfaendner	PP/1-21105/A/CGM 474/PCT/	8274

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PATENT DEPARTMENT  
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EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/04/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,543

Applicant(s)

PFAENDNER ET AL.

Examiner

D. R. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☒ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Restriction Requirement***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims , drawn to 1, 8-15 (for sterically hindered phenols) and 2, drawn to a process for stabilizing plastics with sterically hindered phenol modified polymers, classified in class 525, subclass 69+.
  - II. Claims 1, 8-15 (for sterically hindered amines) and 3, drawn to a process for stabilizing plastics with sterically hindered amine modified polymers, classified in class 525, subclass 69+.
  - III. Claims 1, 8-15 (for lactones) and 4, drawn to a process for stabilizing plastics with lactone modified polymers, classified in class 525, subclass 69+.
  - IV. Claims 1, 8-15 (for sulfides) and 5, drawn to a process for stabilizing plastics with sulfide modified polymers, classified in class 525, subclass 69+.
  - V. Claims 1, 8-15 (for phosphites) and 6, drawn to a process for stabilizing plastics with phosphite modified polymers classified in class 525, subclass 69+.
  - VI. Claims 1, 7-15 (for benzotriazoles), drawn to a process for stabilizing plastics with benzotriazole modified polymers, classified in class 525, subclass 69+.
  - VII. Claims 1, 7-15 (for benzophenones), drawn to a process for stabilizing plastics with benzophenone modified polymers, classified in class 525, subclass 69+.
  - VIII. Claims 1, 7-15 (for triazines), drawn to a process for stabilizing plastics with triazine modified polymers, classified in class 525, subclass 69+.
  - IX. Claim 16 (for sterically hindered phenols), drawn to sterically hindered phenol modified polymers, classified in class 525, subclass 384.
  - X. Claim 16 (for sterically hindered amines), drawn to sterically hindered amine modified polymers, classified in class 525, subclass 379.
  - XI. Claim 16 (for lactones), drawn to lactone modified polymers, classified in class 525, subclass 386.

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- XII. Claim 16 (for sulfides), drawn to sulfide modified polymers, classified in class 525, subclass 343+.
- XIII. Claim 16 (for phosphites), drawn to phosphite modified polymers, classified in class 525, subclass 340+.
- XIV. Claim 16 (for benzotriazoles), drawn to benzotriazole modified polymers, classified in class 525, subclass 375.
- XV. Claim 16 (for benzophenones), drawn to benzophenone modified polymers, classified in class 525, subclass 353.
- XVI. Claim 16 (for triazines), drawn to triazine modified polymers, classified in class 525, subclass 376.

Claims 17 cannot be grouped with the other inventions or examined as it is non-statutory subject matter. If recited to recite an affirmative process step it may also be subject to a restriction requirement.

2. The inventions are distinct, each from the other because:

3. Inventions of Groups I-VIII and IX-XVI are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate products of the Group I-VIII inventions are deemed to be useful as herbicides or molding resins and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. The inventions within Groups I-VIII, and Groups IX-XVI, lack unity of invention unity of invention because the compounds included within the Markush group, i.e.,

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- a. sterically hindered phenols,
- b. sterically hindered amines,
- c. lactones,
- d. sulfides,
- e. phosphites,
- f. benzotriazoles,
- g. benzophenones, and
- h. 1,3,5-triazines.

do not (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. See M.P.E.P. § 803.02.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and/or have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***Election of Species Requirement***

2. This application contains claims directed to the following genera of patentably distinct species of the claimed invention:

- a. sterically hindered phenols as defined by formula I,
- b. sterically hindered amines as defined by formulas II, IIa and IIb,
- c. lactones as defined by formula III,
- d. sulfides as defined by formula IV,
- e. phosphites as defined by formula V,
- f. benzotriazoles, as defined by formula VI,
- g. benzophenones as defined by formula VIb and VIc,
- h. 1,3,5-triazines as defined by formula VIa,
- i. "compatibilisators compounds" as defined in Claims 8-14,
- j. plastics or plastic compositions not defined in the claims.

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5. Applicant is required under 35 U.S.C. § 121 to elect a **single ultimate** disclosed specie for each of the above genera for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Where specific species are not identified in the claims applicant should elect a specific specie from the specification. An alternative method of election is to identify an Example which collectively exemplifies the elected species. Currently, none of the claims appear to be generic to the above species.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

#### ***Conclusion to Restriction and Election of Species Requirement***

9. This rejection is being mailed due to its complexity. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R. Wilson whose telephone number is 703-308-2398.

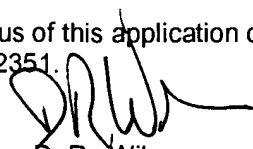
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. Wilson  
Primary Examiner  
Art Unit 1713

February 27, 2003

res: February 27, 2003